REMARKS

Claims 1 through 8 are pending in this application. Claim 1 has been amended and claim 7 and 8 added. Care has been exercised to avoid the introduction of new matter. Indeed adequate descriptive support for the present amendment should be apparent throughout the originally filed disclosure as, for example, Figs. 2 and 3 with respect to claims 1 and 7 and the loss values of examples 1 through 4 in Table I with respect to claim 8. Applicant submit that the present amendment does not generate any new matter issue.

Claims 1-6 were rejected under 35 USC §103 for obviousness predicated by Judy et al. in view of Sillard et al.

In the statement of the rejection the Examiner asserted that Judy et al. discloses one range of the claim as specified in the first paragraph of claim 1 and that Sillard et al. discloses another feature of the claimed invention. The Examiner then announced the obviousness conclusion. The generalization "optimizing WDM Architecture" was offered as motivation (penultimate line of page 3 of the January 30, 2003 Office Action.) This rejection is traversed.

The Examiner has not followed the mandate of the Court of Appeals for the Federal Circuit of making "clear and particular " factual findings as to a specific understanding or a specific technological principal which would have realistically impelled one having ordinary skill in the art to modify particular prior art, in this case the fiber disclosed by the primary reference to Judy et al., to arrive at the claimed invention. *In re Lee, 237 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).* The Examiner has merely asserted that each of the

references discloses different features of the claimed invention and then announce the obviousness conclusion. This approach has been repeatedly traditionally condemned. *In re Kotzab, 217 F.3d 1365, 55 USPQ 1313 (Fed. Cir. 2000); Grain Processing Corp. v. American-Maize Products Co., 840 F.2d 902, 5 USPQ2d 1788 (Fed. Cir. 1988).* Indeed, the Examiner did not even made the requisite factual findings required by *Graham v. John Deere Co., 86 S.Ct. 684, 383 U.S. 1, 148 USPQ 459 (1966).* In short, the Examiner has not provided the requisite factual basis upon which to predicate the conclusion of one having ordinary skill in the art would have been realistically motivated to modify the optical fiber disclosed by Judy et al. to arrive at the claimed invention. *In re Lee, supra.* Generalizations doe not suffice. *Ruiz v. A.B. Chance Co., 234 F.3d 654, 57 USPQ2d 1161 (Fed. Cir. 2000); Ecolochem Inc. v. Southern California Edison, Co. 227 F.3d 1361, 56 USPQ2d 1065 (Fed. Cir. 2000); In re Dembiczak, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999); In re Rouffet, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998).*

At any rate, in order to expedite prosecution, claim 1 has been amended to clarify the range for the average chromatic dispersion. As pointed out in the written description of the specification, notably commencing at page 3, line 21, the present invention seeks to provide an optical transmission line in which the absolute value of the cumulative chromatic dispersion (average chromatic dispersion) is small in a wide wavelength range and which exhibits a small loss **and** which is easy to handle, in addition to providing an optical transmission system using such an optical transmission line. It is not apparent wherein either of the applied references discloses or suggests such a combination of the properties. That the objectives are achieved should be apparent from the data appearing in the

specification which, of course, is entitled to consideration anent the non-obviousness issue. *In re Soni, 54 F.3d 746, 34 USPQ2d 1685 (Fed. Cir. 1995); In re Margolis, 785 F.2d 1029, 228 USPQ 940 (Fed. Cir. 1986).*

Based upon the foregoing, Applicant: submit that the imposed rejection of claims 1 through 6 under 35 U.S.C. §103 for obviousness predicated upon Judy et al. in view of Sillard et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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